

REMARKS

This is in response to the non-final Official Action currently outstanding with respect to the above-identified application.

Claims 1-11 were present in this application as of the time of the issuance of the currently outstanding Official Action. By the foregoing Amendment, Claims 1 and 10 have been amended. No New Claims have been added and no claims have been canceled. Accordingly, upon the entry of the foregoing Amendment, Claims 1-11 will constitute the claims under active prosecution in this application.

The claims of this application showing the changes made by this Amendment are shown above as required by the Rules.

More specifically, it is noted that in the currently outstanding Official Action, the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC 119(a)-(d), and indicated that the required certified copies of the priority document have been received by the United States Patent and Trademark Office.
2. Provided Applicants with a copy of a Notice of References Cited (Form PTO-892) and copies of the references cited therein.
3. Acknowledged Applicants' Information Disclosure Statement by providing Applicants with a copy of the Form PTO-1449 that accompanied that Statement duly signed, dated and initialed by the Examiner to confirm his consideration of the art disclosed therein;

4. Rejected Claims 1 and 3-11 under 35 USC 102(b) as being anticipated by the Kay, et al reference (U.S. Patent 5,444,143).

5. Rejected Claim 2 under 35 USC 103(a) as being unpatentable over the Kay, et al reference as applied to Claims 1 and 3-11 and further in view of the Bernstam reference (U.S. Patent 6,322,868).

Further comment in these Remarks regarding items 1-3 above is not considered to be necessary in these Remarks.

With respect to items 4 and 5, without prejudice to their right to further argue the substance should it become necessary or desirable to do so, Applicants presently rely upon the patentability of the independent claims as support for the patentability of the dependent claims of this application. Accordingly, since Applicants respectfully submit that Claims 1, 10 and 11 are patentable for the reasons set forth below, it is respectfully submitted that Claims 2-9 also are patentable. Further discussion concerning the Examiner's rejection of Claim 2 under 35 USC 103(a), therefore, is not considered to be required at the present time.

With respect to the Examiner's rejections under 35 USC 102(b), Applicants now have amended Claims 1 and 10 in a manner that is believed to more clearly state the subject matter that the Applicants regard as their invention. In view of these amendments, Applicants respectfully submit that there can be absolutely no doubt that the claims of this application are not anticipated by the Kay, et al. reference as suggested by the Examiner in the currently outstanding Official Action.

In order for a rejection of a pending claim based upon anticipation under 35 USC 102(b) to be valid, the Examiner's bases for the rejection must comply with the following:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required." *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) See, MPEP 2131

Applicants respectfully submit that the Examiner's present anticipation rejections under 35 USC 102(b) do not satisfy these tests.

Generally speaking, this is because the Kay, et al reference discloses that the transparent optical element and the grating beam splitter are integrated, and there is no relation between the transparent optical compensation film of the present invention and the elements of the Kay et al reference just mentioned. Further, the function of the optical compensation film of the present invention is clearly described at lines 32-33 of page 5 of the present specification. The grating beam splitter and the transparent optical component of the Kay, et al reference simply do not function in the same manner as the transparent optical compensation film of the present invention. *Spec*

More specifically, the Examiner asserts that the Kay, et al reference discloses an integrated unit that includes elements that meet all of the limitations of the claims of this application. In so doing, the Examiner suggests that the Kay et al reference shows a transparent optical compensation film integrated in the same integrated unit in which the diffraction element and the casing are integrated. In support of this assertion, the Examiner calls attention to the Kay, et al. reference at Column 4, lines 33-47 and Fig. 1, reference numerals 30, 32, 34 and 42. A review of the Kay, et al. references indicates that the numeral 30 refers to the entire "laser-detector grating unit (LDGU)", the numeral 32 refers to a housing, the numeral 34 refers to a transparent substrate, and the numeral 42 refers to a grating beam splitter. **There is absolutely no teaching, disclosure or suggestion in the Kay, et al. reference that the transparent substrate 34 is contemplated to be an optical compensation film or to in any way evidence a compensation function.**

In this regard, it is noted that Kay, et al. define their "transparent substrate" as "any transparent material, including glass, plastic or film which may be used to support a grating beam splitter formed therein or thereon (see Column 5, lines 31-34). The Kay, et al. reference, however, does not contemplate that the transparent substrate 34 therein disclosed is either to be formed integrally with other optical components of the apparatus disclosed, or that the transparent substrate is, or will function as, a compensation film useful in overcoming the birefringence effects of a target optical disk. Indeed, while Kay, et al. realize that so-called circularization of the laser beam is known to be beneficial (see, column 2, lines 9-14), they nevertheless never indicate that their transparent substrate 34 is to demonstrate compensation effects. Indeed, the only statement concerning the optical effects of the Kay, et al. transparent substrate of which Applicants are currently aware states: "(a) zeroth order diffraction component of the radiation beam passes **undeflected** through the transparent substrate 34 and the grating splitter 42 formed thereon and is collimated by the collimating lens 44". (See, Kay., et al., Column 4, lines 54-58)

Accordingly, it will be understood that as far as Kay, et al. are concerned, such compensation effects as are to be accomplished in their system are to be brought about by **a separate lens supported by mounting means separate from the remainder of the apparatus** (See, Kay, et al., Column 3, lines 42-45; Column 4, line 64 to Column 5, line 2; Column 10, line 59 to Column 11, line 16; and Claim 11; among other locations within the Kay, et al. reference). This lens is stated to impart desirable circularity to the laser beam and thereby to "improve throughput efficiency". (See, Kay, et al., Column 3, lines 41-44) Also, as has already been alluded to, Applicants have not been able to locate any teaching, disclosure or suggestion within the Kay, et al. reference to the effect that a compensation film should be integrated with any other element or elements of the apparatus.

The Examiner's reliance upon parts of the Kay, et al. specification such as Column 6, lines 18-24 concerning the fact that a reflector may be (i) supported by a casing cap, (ii) incorporated into the substrate 34 or (iii) otherwise mounted elsewhere within the casing also are respectfully submitted to be inapposite to the disposition of a transparent optical compensation film within the apparatus disclosed. Further, these sections of the Kay, et al. reference also do not recognize or address the problems solved by the present invention as discussed in a summary manner at page 15, final paragraph, of the present specification.

Accordingly, at best, the Kay, et al. reference is an example of the sort of device upon which the present invention is intended to improve. As far as Kay, et al. are concerned, any compensation function required by their apparatus is taken care of by a separate lens that is separately mounted in the optical pathway of the light. Kaye, et al. simply do not teach, disclose or suggest the use of compensation films *per se*, nor do they teach, disclose or suggest that a compensation film integrated with another element of the device will accomplish the required compensation function with fewer components in a smaller unit with less required adjustment. The Kay, et al. reference consequently does not teach disclose or suggest all of the elements of the present invention as set forth in the present claims. Thus, under the above-quoted standards, the Kay, et al. reference clearly and unambiguously fails to anticipate the present invention.

For each and all of the foregoing reasons, it is respectfully submitted (i) that the Examiner's analysis of the cited art is in error as he has applied it to the present claims, (ii) that upon reconsideration the Examiner will agree that his present rejections should be withdrawn for the reasons herein stated, and (iii) that the claims of this application as they will stand upon the entry of the foregoing Amendment are in condition for allowance. Reconsideration of this application and the allowance of Claims 1-11 in response to this communication, therefore, are respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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